

Appln. No. 10/694,555

Reply to Office Action dated January 18, 2006

REMARKS/ ARGUMENTS

Reconsideration of the present application, as amended, is respectfully requested.

The January 18, 2006 Office Action and the Examiner's comments have been carefully considered. In response, remarks are set forth below in a sincere effort to demonstrate that the present application is in form for allowance.

DOUBLE PATENTING

In the Office Action, claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,668,168. In maintaining the rejection, the Action asserts that the claims of the present application are not patentably distinct from the claims of the '168 patent in that, for example, claim 1 of the '168 patent "shows that uplink/downlink control data (information) is lower in dormant state and claim 1 of the instant application states basically the same reduced traffic in dormant state". (see OA, part 1, p.2).

In response, although Applicants reserve the right to file a terminal disclaimer in accordance with 37 C.F.R. 1.321(c), Applicants respectfully request reconsideration of the stated double patenting rejection in view of the following remarks.

First, Applicants respectfully note that generally, a "one-way" test is applied to determine obviousness-type double patenting. Under that test, the Examiner should ask whether the application claims are obvious over the patent claims. Further, under the one-way test, if the scope of the application and the patent claims is not identical, the Examiner must ask whether the former defines merely an obvious variation of the latter. (See, *In re Berg*, 46 USPQ 2d 1226, 1229 (Fed. Cir. 1998)). In addition, under certain circumstances, a "two-way" test has been applied (i.e., an examination of the application claim and the patent claim to determine whether each was obvious in view of the other). (See, *In re Berg*).

With the foregoing in mind, Applicants respectfully submit that the present pending claims (i.e., claims 1-20) are neither obvious nor an obvious variation of the '168 patent claims,

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and further respectfully submit that neither are the '168 patent claims an obvious variation of the present pending claims.

For example, considering pending claim 1, Applicants respectfully note that the '168 patent claims do not require "a communication channel...comprising an uplink control channel and a downlink control channel", as recited in pending claim 1, but rather read on a system with "an uplink control channel" and "a downlink control channel" that need not necessarily be included in a common communication channel. Applicants respectfully further note that the '168 patent claims similarly do not require "a control means for activating [a] traffic reduction means...to cause the uplink and downlink control channels to enter into a dormant state", as also recited in pending claim 1, but rather distinctly read on a system in which a dormant state is entered into "after a first time period has elapsed". That is, the '168 patent claims seem to read on a system that is at least to a certain extent time based, whereas pending claim 1 distinctly is not. Accordingly, based at least on the foregoing, Applicants respectfully submit that pending claim 1, as well as claims 2-5, 15 and 16, which claims depend either directly or indirectly from claim 1, are each patentably distinct from the '168 patent claims.

With regard to pending claims 6, 8 and 17, Applicants respectfully note that the '168 patent claims, as discussed above with respect to pending claim 1, do not require "a control means for activating [a] traffic reduction means...to cause the uplink and downlink control channels to enter into a dormant state", but rather distinctly read on a system in which a dormant state is entered into "after a first time period has elapsed". Thus, at least for reasons similar to those discussed above concerning pending claim 1, Applicants respectfully submit that claims 6, 8, and 17 are likewise patentably distinct from the '168 patent claims.

Concerning pending claims 9, 11 and 18, Applicants respectfully again note that the '168 patent claims, as discussed above with respect to pending claim 1, do not require "a control means for activating [a] traffic reduction means...to cause the uplink and downlink control channels to enter into a dormant state", but rather distinctly read on a system in which a dormant state is entered into "after a first time period has elapsed". Therefore, again at least for the

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reasons previously discussed, Applicants respectfully submit that claims 9, 11, and 18 are patentably distinct from the '168 patent claims.

With respect to pending claims 12, 14, 19 and 20, Applicants respectfully note that the '168 patent claims, as discussed above with respect to pending claim 1, do not require "a communication channel...comprising an uplink control channel and a downlink control channel", but rather broadly read on a system with "an uplink control channel" and "a downlink control channel" that need not necessarily be included in the same communication channel. In addition, pending claims 12-14, 19 and 20 do not require that the uplink control channel and the downlink control channel enter a dormant state "after a first time period has elapsed", as recited via the '168 patent claims. That is, the '168 patent claims seem to read on a method that is at least to a certain extent time based, whereas pending claims 12, 14, 19 and 20 distinctly are not. Accordingly, based at least on the foregoing, Applicants respectfully submit that pending claim 1, as well as claims 2-5, 15 and 16, which claims depend either directly or indirectly from claim 1, are each patentably distinct from the '168 patent claims.

Regarding claims 7, 10 and 13, which claims depend from either claim 6, claim 9 or claim 12, Applicants respectfully submit that such claims are patentably distinct from the '168 patent claims at least because the '168 patent claims do not require "a communication channel...comprising an uplink control channel and a downlink control channel", but rather read on a system or method in which "an uplink control channel" and "a downlink control channel" need not necessarily be included in the same communication channel. Accordingly, at least for this reason, reconsideration and withdrawal of the stated rejection of such pending claims are respectfully requested.

If the Examiner disagrees with any of the foregoing, the Examiner is respectfully requested to point out where there is support for a contrary view.

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Entry of the amendment, allowance of the claims, and the passing of the application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



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